

REMARKS

After entry of this paper, claims 1-21 and 23-64 will be pending in this application. Claims 1-21, 23-24, 27-31, 40-41, 44-47, 52-53, 56-57, and 60-62 are withdrawn. Claim 22 has been cancelled without prejudice. Applicants reserve the right to pursue the subject matter of the withdrawn and cancelled claims in a divisional or continuing application. Claims 25 and 26 have been amended to incorporate the subject matter of the claims from which claims 25 and 26 depend, *i.e.*, claims 19 and 20. Withdrawn claims 56-57 and pending claims 58-59 have been amended to correct the dependencies. No new matter has been added by the introduction of these amendments. Support may be found throughout the specification and claims.

Restriction Requirement

Claims 1-21 and 23-64 are pending in this application and have been subjected to election of an invention group and a single disclosed species for prosecution on the merits under 35 U.S.C. §121. In the Examiner's opinion, as set forth in the Detailed Action, the application contains claims directed to seven patentably distinct inventions as follows:

Group I: claims 1-15, 20-21, and 27, drawn to nucleic acid molecules, classified in at least class 435, subclass 69.1, for example;

Group II: claims 16-19 and 60-62, drawn to polypeptides, classified in class 530, subclass 350, for example;

Group III: claims 23-26, 32-59, and 63-64, drawn to antibodies and compositions thereof, classified in at least class 424, subclass 130.1, for example;

Group IV: claim 28, drawn to a method of identifying or obtaining a human chromosome 20p13-p12 gene, classified in class 435, subclass 6, for example;

Group V: claims 29 and 31, drawn to a method of treating a disorder with a binding compound, classified in class 424, subclass 130.1, for example;

Group VI: claim 30, drawn to a method of treating a disorder with an agonist to a polynucleotide, classified in class undetermined, subclass undetermined; and

Group VII: claim 31, drawn to a method of treating a disorder with an antagonist to a polynucleotide, classified in a class undetermined, subclass undetermined.

As stated above, applicants provisionally elect Group III, including claims 23-26, 32-59, and 63-64 for prosecution. Applicants respectfully disagree with the restriction requirement imposed by the Examiner and the characterizations made of the claimed invention. Accordingly, this election is made with traverse.

Furthermore, the Examiner is of the opinion that the application contains claims directed to patentably distinct species of the claimed invention. However, Applicants provisionally elect SEQ ID NO:5 for prosecution with traverse.

It is the Examiner's position that restriction is appropriate because the groups contain claims that are not coextensive and have divergent subject matter. Applicants respectfully disagree with the Examiner's position.

According to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that (1) the groups of restricted claims are properly presented in the same application; (2) undue diverse searching would not be required; and (3) all claims should be examined together.

The Examiner has not shown that examination of all the pending claims would require undue searching and/or place a serious burden on the Examiner, which is a requisite showing for proper issuance of a restriction requirement. In fact, applicants submit that to properly search any one group, other group classifications must be considered as well to perform a comprehensive search.

Assuming arguendo that the Examiner correctly states that the claimed protein products of Groups I and II are distinct, applicants submit that since the nucleic acid of the Group I claims can encode the proteins claimed in the Group II claims, a search of the claimed DNA molecules and encoded proteins would necessarily overlap, since the nucleic acid sequence

provides a deduced amino acid sequence for the protein. Also, the antibodies of Group III claims the polypeptides having the same sequences of Group II, and would not require additional searching. Thus, as restriction based upon search or examination burden alone would appear to be unjustified, applicants request that the claims of at least Groups I, II, and III, be considered as a single group.

Compositions and methods of those polypeptide and nucleic acid claims may be classified together. Applicants respectfully submit that searching these groups together would not be a serious burden on the Examiner as required by M.P.E.P. §803 if restriction is not required. Applicants respectfully request that the claims of Inventions I, II, and III, as well as claims of Inventions VI - VII which are directed to a method of identifying and obtaining a human chromosome 20p13-p12 gene, a method of treating a chromosome 20 disorder using a molecule which binds Gene 216, be included in Inventions I, II, and III, and/or examined together with the claims of Inventions I, II, and III identified by the Examiner. There would not be a serious burden to search nucleic acids encoding proteins, the encoded proteins, antibodies that bind the proteins, and methods using the nucleic acids, proteins, and antibodies. In fact, there would be overlap. Accordingly, reconsideration of the restriction/election requirement is respectfully requested.

For the above reasons, it is respectfully requested that the Examiner rejoins at least Groups I, II, and III, but preferably rejoins all groups I-VII because there is believed to be no undue or serious burden placed on the Examiner in a search of the art. It is believed that the elected claims are in condition for allowance. Early and favorable action by the Examiner is earnestly solicited.

Applicants respectfully request that the Restriction Requirement be withdrawn and all presented claims be examined on the merits.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the election requirement of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 2976-4039US3.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2976-4039US3.

Respectfully submitted,
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